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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/068,983 | 02/11/2002 | John F. Conroy | | 4610 |

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| EXAMINER |
|---|
| ANDERSON, GERALD A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3637 | |

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/068,983 | CONROY, JOHN F. | |
| | Examiner | Art Unit | |
| | JERRY A ANDERSON | 3637 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *10-13,17-19,24 and 27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 14-16, 20-23, 25, 26, 28-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed June 16, 2003 have been fully considered but they are not persuasive. The applicant argues that just because a cabinet shelves a bottle does not make it a wine rack. The claim to "a wine rack" is a statement of intended use. The applicant is reminded that an invention is entitled to all the uses to which it can be applied. Any rack with a shelf maybe used to store a wine bottle. The Examiner is required to give the claims their broadest reasonable meaning. In this case claim 1 is viewed as defining a partially recessed space having a rack, some structural device such as a cabinet that includes a cradle, another structural device such as a shelf that can be used to support a bottle. The objection to Figure 3 is modified below in view of the applicant's comments.

The Examiner considers that the disclosed structure, as claimed, would not work well for all wine bottles, for example round or rectangular bottles and therefore fail to distinctly claim the invention for the intended use.

### *Election/Restrictions*

Applicant's election without traverse of Figure 1 in Paper No. 7 is acknowledged. Claims 10-13, 17-19, 24 and 27 have been withdrawn from consideration because the applicant has not included these claims in the group readable on the elected species. The claims to be examined are limited to those claims defining elements of the invention clearly shown by the elected Figure . The Examiner has reviewed the application and has withdrawn claims from consideration because the elected Figure does not disclose.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the space between the bars 220, shown as 222 or 105 in Figure 4, must be shown in Figure 3 or the feature(s) canceled from the claim(s). No new matter should be entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 defines the invention in the preamble as a "building". Claims 1-19 defined the invention as a "storage space", in the preamble, that is partially recessed in a wall. It is not understood haw a "space" and a "building" can be equivalents or how a building can be recessed in a wall. Therefore the subject matter which the applicant regards as the invention is unclear. This claim is further indefinite because the storage space has been defined as comprising an enclosure and the difference between a housing and an enclosure is indeterminate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 16, 20-23, 25, 26, 31 and 32, as presented, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Coglin. Coglin is cited showing an enclosures 10, 60 and 80 mounted in a wall 14 between studs 51 and 52, the enclosures have side walls 29 with fastener holes at 47 and 53, the enclosures can have a transparent cover 20 and/or a hinged door 62, the enclosure has a lip 44, the enclosures have shelves 22 to cradle bottles.

***Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 14, 15 and 28-30, as presented, are rejected under 35 U.S.C. 103(a) as being unpatentable over Coglin and further in view of Borgen. The shelves of Coglin may cradle or support a bottle placed horizontally on the shelf but Coglin fails to show a pair of rod in the enclosure. Borgen shows a cabinet with a rack of rods 24 for the purpose of supporting bottles. Since the references are from the same field of endeavor the purpose of Borgen would have been obvious in the pertinent art of Coglin at the time of the invention it would have been obvious for one having an ordinary skill in the art to have modified Coglin with a rack of rods 24 for the purpose of supporting bottles in view of Borgen. Claim 8 defines a particular size enclosure. However, the size of an element is considered an obvious matter of design choice for one having an ordinary skill in the art. The method of using the cabinet of Coglin as a bottle storage rack in a wall is obvious in view of the showing that the apparatus is well known in the art.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Anderson whose telephone number is 703 038 2202. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703 308 24668. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 3597 for regular communications and 703 306 4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 2197.

Jaa
September 8, 2003

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600